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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,483	11/14/2006	Matthias Fies	C 2632 PCT/US	1290

23657 7590 09/11/2009  
FOX ROTHSCHILD LLP  
2000 MARKET STREET  
PHILADELPHIA, PA 19103

EXAMINER
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SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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09/11/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@foxrothschild.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/553,483	<b>Applicant(s)</b> FIES ET AL.	
	<b>Examiner</b> ROBERT SELLERS	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-16 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) 8-14, 25 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15, 16 and 18-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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1. Claims 8-14, 25 and 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. The election was made **without** traverse in the reply filed on March 5, 2009.

2. The 35 U.S.C. 112, second paragraph, rejection has been overcome by defining the mixture of acrylic or methacrylic compounds as "obtained" by the ensuing process.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15, 16 and 18-24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a molar ratio of exactly 2:1 on page 3, lines 6-7, does not reasonably provide enablement for the molar ratio of "about" 2:1 defined in claim 15, line 8. Furthermore, the esterification of "substantially" all free hydroxyl groups denoted in claim 15, line 9 is not enabled by page 3, lines 18-19 describing "esterifying all the free OH groups." The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The text of sections 112, second paragraph, and 103(a) of Title 35, U.S. Code not included in this action can be found in the non-Final rejection mailed April 1, 2009.

Claims 15, 16 and 18-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. The parameters of the term "substantially" use to quantify the esterification in claim 15, line 9 are unclear since page 3, lines 17-23 of the specification does not indicate what minimum level of esterification satisfies the term.

4. The phrase denoting the presence of excess acrylic acid and/or methacrylic acid after steps a) and b) in claim 15, lines 12-13 would be more concisely defined as "wherein an excess of acrylic acid and/or methacrylic acid is present after step a), or steps a) and b)" since step b) is optional.

Claims 15, 16 and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beck et al. Patent No. 5,096,938 in view of Kigawa et al. Patent No. 5,798,434 and European Patent No. 126,341.

Claims 15, 16 and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent No. 10-218946 in view of Beck et al. and the European patent.

The rejections are maintained for the reasons of record set forth in the non-Final rejection. The arguments filed July 1, 2009 have been considered but are unpersuasive.

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5. Beck et al. in column 2, lines 1-4 discloses the reaction of 1 equivalent of a polyhydric alcohol such as preferably oxyethylated trimethylolpropane (col. 2, lines 20-22) with from 0.05 to 1 equivalent of a polybasic carboxylic acid such as adipic acid (col. 2, line 28) which converts to a molar ratio of from 20:1 to 1:1, thereby encompassing the claimed molar ratio of about 2:1. There is no evidence of record distinguishing the claimed molar ratio over the range disclosed in Beck et al., particularly the closest prior art molar ratio inherent in Example 3 in column 4.

6. The claimed mixture of (meth)acrylic compounds containing from 1 to 35% by weight of epoxy(meth)acrylates obtained by steps a), b) and c) constitutes product-by-process language.

According to MPEP § 2113, Product-by-Process Claims: Product-By-Process Claims are not Limited to the Manipulations of the Recited Steps, Only the Structure Implied by the Steps:

”[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” (*In re Thorpe*, 227 USPQ 964, 966, Federal Circuit 1985). “[T]he burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product.”

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(MPEP § 2113, Burden Shifts to the Applicant to Show an Unobvious Difference and *In re Marosi*, 218 USPQ 289, 292, Federal Circuit 1983).

7. Based on the equivalent reactants used to prepare the polyester polyol wherein the molar ratio of the reference encompasses that claimed along with the reaction with as much as 1.5 equivalents of (meth)acrylic acid (Beck et al., col. 2, lines 5-6) inherently resulting in excess (meth)acrylic acid, the claimed reaction product is obvious from that of the prior art. The burden shifts to applicants to provide evidence distinguishing the claimed reaction product from that of Beck et al. No such evidence is currently of record.

8. The claimed "flatting composition" merely indicates the ultimate intended utility of the mixture of coating component (A) and dimerdiol component (B) and is not a critical limitation since it does not add any particular physical or other features thereto.

The amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL** (MPEP § 706.07(a)). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

(571) 272-1093 (Fax No. (571)-273-8300)  
Monday to Friday, 9:30 to 6:00

/Robert Sellers/  
Primary Examiner  
Division 1796

rs  
9/9/2009